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| PERKINS COIE LLP PATENT-SEA P.O. BOX 1247 SEATTLE, WA 98111-1247 | | | EXAMINER BUTLER, DENNIS | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/796,571

Applicant(s)

MACKIN ET AL.

Examiner

Dennis M. Butler

Art Unit

2115

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-87 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37-87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. This action is in response to the amendment received on February 5, 2007.

Claims 37-87 are pending. Claims 84-87 have been added.

2. The text of those sections of Title 35, US Code not included in this action can be found in a prior Office Action.

3. The rejection of claims 38-40, 48-61, 63-65, 70-73 and 77-83 under 35 U.S.C. 112, first paragraph, has been withdrawn in view of applicant's amendments and arguments including footnote 1 at the bottom of page 14 of the remarks that were received on February 5, 2007. However, the examiner maintains that the specification does not enable the injecting and infusing of configuration settings into the target computer for the reasons set out in paragraph 3 of the office action mailed on October 4, 2006.

4. Applicant's terminal disclaimer was received on February 5, 2007. However, the terminal disclaimer has not yet been reviewed and approved by a paralegal. The obviousness double patenting rejection has been maintained for this reason. The obviousness double patenting rejection will be withdrawn when the terminal disclaimer has been approved by a paralegal.

5. Claims 37, 41-47, 62, 67-69 and 74-76 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 6-8, 11, 16-18 and 25 of U.S. Patent No. 6,728,877. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to substantially the same invention including identifying locations of configurations, selecting/indicating settings that can be extracted and extracting the selected settings.

The claims differ from the patent in that the patent does not explicitly recite storing the extracted settings on a storage device. However, the patent recites that the extracted settings are provided to a target computer and it would have been obvious to provide the settings to the target computer using a storage device. In addition, the application includes claims that are generic to the species of invention covered by the patent and the generic invention recited in the applications claims is anticipated by the species of the patented invention. Claims 37 and 62 of the application correspond to claims 1 and 16 of the patent. Claims 41-47 and 67-69 of the application correspond to claims 3 and 6-8 of the patent. Claim 74 of the application correspond to claims 1, 11, 16 and 25 of the patent. Claims 75 and 76 of the application correspond to claims 2-3 and 17-18 of the patent.

6. Claims 51-53, 62-64, 66, 70, 74-77, 79-82 and 85-87 are rejected under 35 U.S.C. 102(e) as being anticipated by Hunter et al., U. S. Patent 6,161,176.

Per claims 51-53, 62-64, 70, 74, 77, 79 and 82:

A) Hunter et al teach the following claimed items:

1. providing/presenting configuration information identifying locations of configuration settings with INI file 74 of figures 2 and 3 and at column 6, line 55 – column 7, line 7;
2. providing a selection of configuration settings to be extracted at column 3, lines 17-33, at column 6, lines 42-54 and at column 12, lines 52-57;
3. extracting the selected configuration settings from the locations of the source computer (computer 1) at column 9, lines 48-64;

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4. manipulating at least one of the extracted configuration settings from a format used on the source computer to a format used on the target computer with the environment variables (%userprofile%) or tokens at column 7, lines 41-55, at column 10, lines 28-66, at column 11, lines 48 – column 12, line 1 and at column 13, lines 41-53;
5. storing the extracted and manipulated settings on a storage device in a format that can be used by the target computer (computer 2) to control its operation with settings file 90 of figures 3 and 4 and at column 10, lines 17-27;
6. providing the target computer with the configuration settings, transitioning the target computer based on the personality of the source computer and using the settings to control the operation of the target computer with figures 4 and 6, at column 3, lines 3-16, at column 11, lines 6-47 and at column 13, lines 31-67;
7. applying the retrieved configuration settings into the target computer using an installing application (wizard) with figures 4 and 6, at column 3, lines 3-16, at column 11, lines 6-47 and at column 13, lines 31-67.

Per claim 66:

Hunter describes receiving a user selection of configuration settings stored on the storage device that are to be installed on the target computer at column 12, lines 24-42.

Per claims 75-76 and 80-81:

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Hunter describes personality objects of the source computer that specify configuration settings with wizard 38 of computer 1 in figures 2, 3 and 5 and at column 12, line 52 – column 13, line 30.

Per claims 85-87:

Hunter describes extracting registry settings at column 1, lines 43-56, at column 2, lines 37-46, at column 6, lines 33-41 and at column 9, lines 48-64.

7. Claims 37-50, 54-61, 65, 67-69, 71-73, 78 and 83-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al., U. S. Patent 6,161,176.

Per claim 37:

A) Hunter et al teach the following claimed items:

1. providing configuration information identifying locations of configuration settings with INI file 74 of figures 2 and 3 and at column 6, line 55 – column 7, line 3;
2. receiving a selection of configuration settings to be extracted at column 3, lines 17-33, at column 6, lines 42-54 and at column 12, lines 52-57;
3. extracting the selected configuration settings from the locations of the source computer (computer 1) at column 9, lines 48-64;
4. manipulating at least one of the extracted configuration settings from a format used on the source computer to a format used on the target computer with the environment variables (%userprofile%) or tokens at column 7, lines 41-55, at column 10, lines 28-66, at column 11, lines 48 – column 12, line 1 and at column 13, lines 41-53;

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5. storing the extracted and manipulated settings on a storage device in a format that can be used by the target computer (computer 2) to control its operation with settings file 90 of figures 3 and 4 and at column 10, lines 17-27.

B) The claims differ from Hunter et al in that Hunter et al fails to explicitly teach displaying an indication of configuration settings that can be extracted from the source computer as claimed.

C) However, Hunter describes that a user creates a settings file of the users settings using a wizard application at column 3, lines 17-33, at column 6, lines 42-54 and at column 12, lines 52-57. The wizard application queries the user in natural language and performs a more complex task in response to the users input. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the wizard query the user by displaying an indication of configuration settings that can be extracted from the source computer in order to provide the user a list of the possible configurations that can be extracted that the user can select from rather than make the user develop the list themselves.

Per claims 38-40, 48-50, 54, 65, 78 and 83-84:

Hunter describes installing the configuration settings into the target computer using an installing application (wizard) with figures 4 and 6, at column 3, lines 3-16, at column 11, lines 6-47 and at column 13, lines 31-67. Hunter does not describe locating the installing application (wizard) on the storage device.

However, Hunter describes that the installing application is located on a storage

device on the target computer with wizard 38 of figure 4, at column 11, lines 15-32 and with figure 6. It would have been obvious to one of ordinary skill in the art to locate wizard 38 on memory device 88 of computer 2 in order to provide computer 2 with the wizard application. Hunter describes extracting registry settings at column 1, lines 43-56, at column 2, lines 37-46, at column 6, lines 33-41 and at column 9, lines 48-64.

Per claims 41-47, 55-61, 67-69 and 71-73:

Hunter describes using a computer that includes operating system 35, application programs 36 and both local and wide area network connections 51, 52 with figure 1. Claims 41-47, 55-61, 67-69 and 71-73 recite well known programs and settings commonly provided with operating systems and network communication programs and it would have been obvious to one of ordinary skill in the data processing art to extract configuration settings from such programs in order to transfer the users custom settings to another computer.

8. Applicant's arguments filed on February 5, 2007 have been fully considered but they are not persuasive.

In the Remarks, applicant has argued in substance that:

A. Hunter generally describes transferring settings from a first computer to a second computer, Hunter fails to teach or suggest manipulating configuration settings.

9. As to point A, the examiner disagrees with applicant's contentions. Hunter describes including tokens and environmental variables in the extracted settings as

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described in the above rejections. The tokens and environmental variables allow the settings to be manipulated from a format used in the first (source) computer to a format used by the second (target) computer by allowing differences in registry paths and directory paths to be resolved to the proper name for the second computer. Hunter clearly describes manipulating configuration settings.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis M. Butler whose telephone number is 571-272-3663. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dennis M. Butler
Dennis M. Butler
Primary Examiner
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